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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/412,510	10/05/1999	KENJI ITOH	0756-2045	9753

7590 03/29/2004

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EXAMINER

PADGETT, MARIANNE L

ART UNIT PAPER NUMBER

1762

DATE MAILED: 03/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/412,570

Applicant(s)

ITOH et al

Examiner

M.L. Padgett

Group Art Unit

1762

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 10/21/03 + Petition + withdraw from issue
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 42-86 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 42-86 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

(10/21/03)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 39
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 20, 2003 has been entered.

2. The IDS submitted with the RCE of October 21, 2003 is made of record, and it is noted that the submitted US Patent references lack teachings on plasma distributions like those claimed, associated with the claimed electrode/inlet configuration, hence are not considered to read on the previously allowed claims.

The submitted application SN 09/438,581 has been reviewed, and while the claims submitted therewith do not concern the above distributions and configurations, those presently in that case are a broader description of the instant claims, such that distributions and electrode configurations of 438,581 are inclusive of the presently claimed, or are generic thereto. The art rejections made in the (581) case were reviewed, but as the instant case is more specific as to its electrode/inlet structure and the localized plasma effect extending therefrom, these rejections are not considered relevant to the present case, except for the obvious double patenting over PN 6,001,432, which is analogue to (581), but was previously treated in a previous obviousness type double patenting rejection (section No. 5, Paper No. 27, mailed July 5, 2003).

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 42-86 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 34, 36, 38, 40-42, 44-46 and 48 of copending Application No. 09/438,581. Although the conflicting claims are not identical, they are not patentably distinct from each other because as noted above, the application claims of (581) are the generic to the specific features of the instant invention, hence totally encompass this set of claims.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

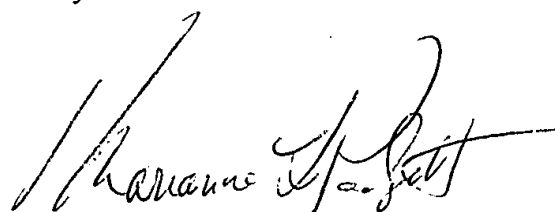
5. Claims 42-86 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 35, 39, 43, 47, 49 and 51-52 of U.S. Patent No. 09/438,581 in view of Jansen et al (5,073,785).

These claims further differ by being directed to a different result in the (581) application, that of depositing a film comprising carbon, instead of etching with a plasma of an analogous configuration. While the instant claims are directed to the etching technique of ashing, it is old and well known in the plasma art that plasma apparatus/process are useful for both etching and coating (CVD, PECVD) techniques. Jansen et al (785) illustrates use of carbon-containing gas compounds as claimed in (581) to produce C-containing films as required, via a plasma process (Abstract, figure, Summary; Ex. 1), where the example 1 also illustrates that the same apparatus is initially used for a plasma cleaning and descumming operations, thus an etching process, hence it would have been obvious to one of ordinary skill that the procedure of the instant claims would have been expected to have been useful for other processes than ashing, and that the generic claims of (581) would have been expected to also be useful for the specific process of etching, not just C-coating, as suggested by the range of uses illustrated by Jansen et al (785).

On recent of a valid terminated disclaim the case would again appear to be ready for allowance.

6. Any inquiry concerning this communication should be directed to Marianne L. Padgett whose telephone number (571) 272-1425 on Monday-Friday from about 8:30 a.m. to 4:30 p.m.; and fax phone number is (703) 872-9306.

M.L. Padgett/dh
March 10, 2004 & March 25, 2004



**MARIANNE PADGETT
PRIMARY EXAMINER**